



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,327	08/18/2003	Kao Wan Lee	4407-0108P	1967

2292 7590 02/18/2005

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

EASTHOM, KARL D

ART UNIT PAPER NUMBER

2832

DATE MAILED: 02/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Ak

Office Action Summary	Application No. 10/642,327	Applicant(s) LEE ET AL.	
	Examiner Karl D. Easthom	Art Unit 2832	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-10 and 12-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-10 and 12-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2832

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “intervals among each said plurality of compensating elements”, LA, DA, and DB must be shown or the feature(s) canceled from the claim(s). It is also noted that the new Figure 5A cannot be correct, or is not clear, or aid in written description, because for example, the length DA as denoted does not correspond to any originally specified element. That is, DA represented a distance of sliver paste originally, but does not correspond to any such element in the new Figure 5A. Also, the distance now shown for LA corresponds to no original silver paste distance shown. Note that the original material for the resistive section is ITO, indium tin oxide, for element 520, so that element 540 is made out of ITO also as etched on either side. The remarks for DB in the new paragraph, to be added on page 8, line 8, does not appear to correspond to the original written description. No new matter should be entered.

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted

Art Unit: 2832

by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. The amendment filed 12/30/4 including the drawings and amendments to the specification is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows and as noted above: The additions to the figures are new matter, including DA, LA, and LCn, as are the new units proposed in the paragraph beginning on page 7, line 7. It is further noted that the new units proposed and old units do not make sense because RG/DB results in units of ohms per inches squared under the proposed amendment, and a number LCO in inches is subtracted. In the original version, the units of RG/DB results in units of ohms per inch, while LCO in inches is subtracted. The whole new paragraph to be added on page 8, line 8 is new matter, describing the units, since these were not originally described nor sufficiently described to decipher. Basically, in any case, all changes made heretofor, except "comprises" claim 5, and "the material ...being silver paste", claims 1, and 9, are new matter. It is also noted that the new Figure 5A cannot be correct, or is not clear, or aid in written description, because for example, the length DA does not correspond to any originally specified element but is now described in relation to a compensating element, but was a silver paste line distance of some sort originally. Also, the distance now shown for LA corresponds to no original silver paste section shown, where for example, 530 is disclosed as the silver paste resistive section. The original material for the resistive section appears to be ITO, indium tin oxide, for element 520, so the remarks for DB in the new paragraph, to be added on page 8, line 8 does not help, or

Art Unit: 2832

does not appear to correspond to the original written description. Any etched part 540' would be a void of ITO, with 540 being ITO.

3. Applicant is required to cancel the new matter in the reply to this Office Action.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 5 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear what LA or DA as not clearly defined, or for reasons noted elsewhere herein. Also ITO is not defined and/or lacks antecedent basis in the claim so that "contact length" between that and silver paste is also not clear. It is not clear what the difference between "line distance" "contact length" and "distance of silver paste pattern are"; i.e., the differences between LA, DA and DB are not clear. Also, for reasons noted elsewhere, the units are not clear.

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-3, 5-10, 12-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. It is not clear what the "intervals among each said plurality of compensating elements are" where the term is not defined in the specification sufficiently, and there is no

Art Unit: 2832

depiction of the term in the figure. That is, there is no depiction or adequate description of intervals between compensating elements 540 in Fig. 5a that decrease toward the middle in size as claimed where the claim recites that the “sizes ofthe intervals among each said plurality of compensating elements are ...inversely proportional to the distances being apart from the edges”. If anything the intervals between elements 540 at the edge appear to be smaller than they are in the middle, so the claim is not described because the intervals are not inversely proportional. For claims 5 and 14, the equation elements DA, LA are not sufficiently described. The new units are new matter and therefor lack original description. For reasons noted above, the “line distance”, “contact length” and “distance of silver paste pattern” are not sufficiently described so that neither is LA, DA and DB

8. Applicant's arguments filed 12/29/5 have been fully considered but they are not persuasive. Applicant adds changes noted above to the specification to overcome the written description rejection. All changes being new matter, the claims are not originally described.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 2832


however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl D Easthom whose telephone number is (571) 272-1989.

The examiner can normally be reached on M-Th, 5:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Elvin Enad can be reached on (571) 272-1990. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Karl D Easthom
Primary Examiner
Art Unit 2832

KDE